REMARKS/ARGUMENTS

Status of the Application

Prior to entry of this Amendment, claims 1, 2, 5, 17-18, 21, 28 and 29 were pending. An office action rejected claims 1-2 and 17 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,401,118 B1 to Thomas (hereinafter, "Thomas") in view of U.S. Patent No. 6,611,830 B2 to Shinoda et al. (hereinafter, "Shinoda"); and claims 5, 18, 21, 28, and 29 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,401,118 B1 to Thomas in view of Shinoda, and further in view of Pub. No. US2002/0156774 A1 to Beauregard et al. (hereinafter, "Beauregard").

This Amendment neither amends, adds, nor cancels any claims. Hence, after entry of this Amendment, claims 1, 2, 5, 17-18, 21, 28 and 29 will remain pending for examination. Claims 1 and 5 are independent claims.

Claim Rejections

The office action rejected all pending claims under § 103(a) as being unpatentable over the combination of Thomas and Shinoda, taken, in some cases, with Beauregard. These rejections are respectfully traversed. In order to support a prima facie case that a claim is unpatentable under § 103(a), an office action must establish, inter alia, that each element of the rejected claim is taught or suggested by the cited references. MPEP § 2143. The office action fails to meet this requirement with respect to any pending claim, and all of the claims therefore are believed to be allowable over any combination of Thomas, Shinoda and Beauregard.

For example, claim 1 recites, inter alia,

> providing search results of identified matches in the contents of the Web page corresponding to the search string, wherein the search results are extracted from the Web page, categorized, and formatted in a report, each category including at least one character string corresponding to a number of occurrences of the identified matches within the category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text, and wherein the search results highlight the at least one trademark, tradename, celebrity name, or famous name found in the Web page.

The office action asserts that Thomas teaches this element of claim 1. A review of Thomas reveals that Thomas does teach several different styles of reports. *See* Thomas, Figs. 6-10. Thomas, however, does not teach or suggest the type of report recited by claim 1. For example, Thomas nowhere teaches or suggests that a report might "display[] the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text," as recited by claim 1.

Instead, Thomas's reports merely provide a list of URLs, based on some scoring algorithm. While Thomas, in some of the disclosed embodiments, does report the nature of the page (i.e., personal, commercial, etc.) on which the search string was found, along with providing contact information for the owner of the page, *see, e.g., id.*, Figs. 6-8, Thomas's disclosed reports fail to provide any information about the search string or where that search string was found in a particular search result (i.e., meta-text, hidden text, etc.), let alone the column format recited by claim 1. In fact, Thomas fails even to disclose that a report might display a number of occurrences of the search string within a search result (e.g., web page), as recited by claim 1.

Nor does Thomas teach or suggest that "the search results highlight the at least one trademark, tradename, celebrity name, or famous name found in the Web page," as recited by claim 1. Indeed, Thomas does not even suggest that the search results might be provided on a report. Instead, as noted above, Thomas focuses on providing "meta-information" (e.g., owner name, nature of site, etc.) about the web sites. Hence, the reports disclosed by Thomas are fundamentally different from those recited by claim 1, and no reasonable construction of Thomas would permit the inference that Thomas even approaches suggesting these recited features.

For its part, Shinoda fails to provide any teaching or suggestion that might supplement Thomas's missing disclosure in this regard. For at least these reasons, claim 1 is allowable over the combination of Thomas and Shinoda.

In addition, however, claim 1 recites "determining an unauthorized use of the at least one trademark, tradename, celebrity name, or famous name." The office action concedes that Thomas fails to teach or suggest this element, but argues that Shinoda does teach "an

unauthorized user to modifying the trademark or famous name over a network." Office Action, at 4 (citing Shinoda, c. 1, ll. 40-46 and c. 6, ll. 42-67). The cited passages of Shinoda, however, describe the use of a "digital watermark" to mark copyrighted works. Even assuming Shinoda might use such watermarks to search for multimedia files, *see, e.g.*, Shinoda Abs., Shinoda does not teach or suggest that its system has anything to do with searching or analyzing a "trademark, tradename, celebrity name, or famous name," let alone "determining an unauthorized use of [a] trademark, tradename, celebrity name, or famous name," as recited by claim 1. For at least this additional reason, the combination of Thomas and Shinoda fails to teach or suggest each element of claim 1.

Claim 1 further recites "wherein the at least one trademark, tradename, celebrity name, or famous name to be searched is provided in an encrypted connection authenticated by a certificate server." The combination of Shinoda and Thomas collectively fails to teach or suggest this element as well. The office action cites col. 11, lines 30-67 and col. 16, lines 40-67 of Thomas as teaching this element, but neither of these passages contain even a hint that a trademark, tradename, celebrity name, or famous name to be searched might be provided in an encrypted connection authenticated by a certificate server. In fact, both of the cited passages discuss providing output of the search results (i.e., reports), not providing the term to be searched. Moreover, even this discussion of reports fails to provide any details about any type of connection used to provide the reports, let alone specifying that such information (or, for that matter, any information) might be provided in "an encrypted connection authenticated by a certificate server," as recited by claim 1.

Hence, it is respectfully submitted that the office action fails to establish a prima facie case that claim 1 is unpatentable, and reconsideration of claim 1 is respectfully requested.

Nor does the office action establish a prima facie case that claim 5 is unpatentable. The office action rejected claim 5 under § 103(a) as being unpatentable over the combination of Thomas, Shinoda and Beauregard. Taken in combination, however, these references fail to teach or suggest each element of claim 5.

For example, claim 5 recites, inter alia,

> providing search results of identified matches in the contents of the Web page corresponding to the search string, wherein the search results are extracted from the Web page, categorized, and formatted in a report, each category including at least one character string corresponding to a number of occurrences of the identified matches within the category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text, and wherein the search results highlight the at least one trademark, tradename, celebrity name, or famous name found in the Web page;

Similar to the rejection of claim 1, the rejection of claim 5 relies on Thomas as teaching this element. As noted above, however, neither Thomas nor Shinoda teaches the recited features of this element. Beauregard, which is cited by the office action only as teaching "word dictionary for lookup and checking spelling including homonyms or phonetic or synonyms" likewise fails to teach this element. Hence, the cited combination fails to teach or suggest this element, and claim 5 therefore is allowable over the cited combination for at least this reason.

(In fact, Beauregard fails even to teach the element against which it is cited, "the automatically created homonyms and phonetic equivalents based on the at least one trademark, tradename, celebrity name, or famous name entered by the user." While Beauregard may teach a synonym dictionary, Beauregard provides no mention of either homonyms or phonetic equivalents.)

Claim 5 also recites, "determining an unauthorized use of the at least one trademark, tradename, celebrity name, or famous name." As noted above, neither Thomas nor Shinoda teach this element, either. Similarly, claim 5 recites, as does claim 1, "wherein the at least one trademark, tradename, celebrity name, or famous name to be searched is provided in an encrypted connection authenticated by a certificate server," and, as noted above, the combination of Thomas and Shinoda fails to teach this element as well. Beauregard is of no additional benefit with respect to either of these elements. Hence, for at least this additional reason, the cited combination fails to create a prima facie case that claim 5 is unpatentable.

Accordingly, both claim 1 and claim 5 are believed to be allowable over any combination of Thomas, Shinoda and Beauregard. Claims 2, 17-18, 21, 28 and 29 each

ultimately depend from either claim 1 or claim 5, and those claims are believed to be allowable at least by virtue of their dependence from allowable base claims. Accordingly, reconsideration of the rejected claims is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Chad E. King/
Chad E. King
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
Attachments
CEK:jep
61055988 v1